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FINNEMAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER	KUCAB, JAMIE R
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/803,396	<b>Applicant(s)</b> NONAKA, AKIRA
	<b>Examiner</b> JAMIE KUCAB	<b>Art Unit</b> 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 April 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-18,26,31 and 33-35 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5) Claim(s) \_\_\_\_\_ is/are allowed.
  - 6) Claim(s) 1,3-18,26,31 and 33-35 is/are rejected.
  - 7) Claim(s) \_\_\_\_\_ is/are objected to.
  - 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

*Acknowledgements*

1. In view of the Appeal Brief filed on April 10, 2008, PROSECUTION IS HEREBY REOPENED. A non-final office action is set forth below.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
  - (1) file a reply under 37 C.F.R. §1.111 (if this Office action is non-final); or,
  - (2) initiate a new appeal by filing a notice of appeal under 37 C.F.R. §41.31 followed by an appeal brief under 37 C.F.R. §41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 C.F.R. §41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

3. Claims 1, 3-18, 26, 31, 33-35 are pending in the application.
4. This Office Action is given Paper No. 20080515 for reference purposes only.
5. Based on a comparison of the PGPub 2002/0035492 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

***Claim Objections***

6. Claims 1 and 31 are objected to because the wording of the claim does not make grammatical sense. For instance, the limitation of "wherein said examining means;" is grammatically incorrect. Appropriate correction is required.
7. Claim 26 is objected to because the wording of the claim does not make grammatical sense. For instance, the limitation of "wherein said examining;" is grammatically incorrect. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 1, 3-18, 26, 31, and 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 1 twice recites the limitation "a mounted recording medium". Are these the same medium? Or are they different media?
11. Regarding claims 1 and 31, Applicant's recitation "examining means for..." would be unclear to a person having ordinary skill in the art. Based on pg. 1 (4<sup>th</sup> line from the bottom) and pg. 4, lines 12-13 of Applicant's replacement section V of the Appeal Brief filed April 10, 2008, the structure corresponding to the "examining means for..." is the Electronic Music Distribution System 1 (Fig. 1). First, it is unclear how many structures are encompassed by this "examining means for..." limitation. EMD System 1 as shown in Fig. 1 appears to contain five different computers. Is this examining means all five computers? Is it one of the computers? Is it an apparatus contained within each of the computers? Second, the "examining means for..." also appears to be the same system as is recited in the preamble of claim 1. Is the examining means the entire system? Or is it a specific structure within the system? Is the scope of claim 31 an apparatus within the system or the entire EMD system? Third, in a means-plus-function claim in which the disclosed structure is a computer (or multiple computers) programmed to carry out an algorithm, the corresponding structure must include a specific algorithm disclosed in the specification.
12. Regarding claims 1 and 31, Applicant's recitation "controlling means for ..." would be unclear to a person having ordinary skill in the art. Based on page 2, line 2 and pg. 4, line 17 of Applicant's replacement section V of the Appeal Brief filed April 10, 2008, the structure corresponding to the "controlling means for..." is the CPU 510. In a means-plus-function claim in which the disclosed structure is a computer or a microprocessor programmed to carry out an

algorithm, the corresponding structure must include a specific algorithm disclosed in the specification.

13. Regarding claim 31, the limitation "... based on results of said examination the result of said examination" is unclear and does not make grammatical sense. Is there one result or two results?

14. Claim 31 thrice recites the limitation "a mounted recording medium" (or similar). Are these the same medium? Or are they different media?

15. Regarding claim 26, Applicant's recitation "examining usage space information of content data distributed on a recording medium mounted in a reproducing apparatus, a recording medium mounted in said reproducing apparatus, said reproducing apparatus, a recording medium mounted in a recording medium, and said recording apparatus" would be unclear to a person having ordinary skill in the art. First, it is not clear whether this is a single step or five different steps. Second, it is not clear where this step takes place. Third it is unclear what is being examined. For purposes of examination, the Examiner is interpreting this as a single step occurring somewhere between the reproducing apparatus and the recording apparatus. If Applicant's intent was for five different structures or signals to be examined, Applicant is advised to clarify this by breaking this single limitation out into five different limitations properly delineated as per MPEP 608.01(i). Assuming Applicant intends this to be five different steps, it is still unclear what is being examined. For example, in the "fourth" examining step, is the method *examining usage space information of a recording medium mounted in said recording apparatus?* Or is the method *examining a recording medium mounted in said recording apparatus?* Or is the method *examining usage space information of content data*

*distributed on a recording medium mounted in said recording apparatus?* This lack of clarity would then be compounded when the results of the examination are used in the controlling step, and further compounded when the usage space information is further defined later in the claim.

16. Claim 26 recites the limitation "said recording medium" in line 16. There is insufficient antecedent basis for this limitation in the claim.

### **Claim Rejections - 35 USC § 103**

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1, 3-18, 26, 31, and 33-35 are rejected under 35. U.S.C. § 103 as being unpatentable over Ryan (US 5,513,260 A) in view of Stefik (US 5,629,980 A) and in further view of Vogel (US 5,446,488).

### **Claims 1, 26, and 31:**

19. Ryan (See at least Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) discloses a means for reproducing content (CD-player), a recorder (CD-recorder) and means there between for examining and controlling transfer (black boxes) substantially as claimed. The differences between the above and the claimed invention is the use of explicit control. It is noted that a committed content duplicator would control and examine files illicitly copied (and has done so since for at least a decade with the advent of peer to peer file sharing) and is therefore believed to

be the functional equivalent of the claimed limitations. Ryan does not explicitly disclose copying digital data on an optical medium. Stefik, however, in at least column 1, lines 10-24 teaches the reproduction of optical media. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist.

20. Ryan does not disclose the newly-added limitation of wherein said usage space information indicates system information of said recording apparatus and said reproducing apparatus, ownership right information of said content data, format information of said content data, and distributing profit information obtained by the distribution of said content data. Stefik, however, in at least Figure 15 as well as associated text does disclose the controlled copying of digital data in a digital rights management environment to include system formation (items 1504, 1505, 1506), ownership rights information (items 1501- 1503), format of digital data (item 1506), and profit distribution (items 1517-1525). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cd recording system of Ryan with Stefik's Digital Rights Management techniques because, "A fundamental issue facing the publishing and information industries as they consider electronic publishing is how to prevent the unauthorized and unaccounted distribution or usage of electronically published materials. Electronically published materials are typically distributed in a digital form and recreated on a computer based system having the capability to recreate the materials. Audio and video recordings, software, books and multimedia works are all being electronically published. Companies in these industries receive royalties for each accounted for delivery of the materials,

e.g. the sale of an audio CD at a retail outlet. Any unaccounted distribution of a work results in an unpaid royalty (e.g. copying the audio recording CD to another digital medium)" (Stefik: column 1, lines 10-24).

21. Regarding the amended limitations of claims 1, 26, and 31, Ryan does clearly teach an examining means for deciding whether said recording medium is of a first type having a configuration enabling recorded data to be effectively read out by performing authentication processing or of a second type having no such configuration and enabling read out of the recorded data without authentication (col. 3, line 63 - col. 4, line 11), examining means for deciding whether said reproducing apparatus is of a first type for reproducing after the authentication processing or of a second type for reproducing without that processing (col. 3, line 63 - col. 4, line 11), and examining means for deciding whether said recording apparatus is of a first type for recording after the authentication processing or of a second type for recording without that processing (col. 3, line 63 - col. 4, line 11). However, Ryan does not explicitly teach an examining means that decides whether data is to be distributed in encrypted or unencrypted form.

22. Stefik does teach a means for distributing data in its unencrypted state, but does not teach this in combination with the sending of data in its encrypted state (Table 2).

23. However, Vogel does teach an examining means to decide whether data should be transmitted in its encrypted or unencrypted state (col. 3, lines 28-48. Therefore, it would have been obvious to one of ordinary skill in the art to combine the references of Vogel and Ryan for the useful purpose of either forcing people to pay to be able to receive and decode the programs, or on the contrary, allowing anyone to view the program without payment, as taught by Vogel.

**Claim 3:**

24. Regarding disabling limitations of claim 3, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 4:**

25. Regarding disabling limitations of claim 4, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied

items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 5:**

26. Regarding the enabling limitations claim 5, Ryan (See Fig 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

**Claim 6:**

27. Regarding the enabling limitations claim 6, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

**Claim 7:**

28. Regarding disabling limitations of claim 7, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between

reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 8:**

29. Regarding disabling limitations of claim 8, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 9:**

30. Regarding the enabling limitations claim 9, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

**Claim 10:**

31. Regarding the enabling limitations claim 10, Ryan (See Fig. 1, Col. 1, liras 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

**Claim 11:**

32. Regarding disabling limitations of claim 11, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 12:**

33. Regarding disabling limitations of claim 12, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between

reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 13:**

34. Regarding the enabling limitations claim 13, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 3 0-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

**Claim 14:**

35. Regarding the enabling limitations claim 14, Ryan (See Fig. 1, Col. 1, lines 60-65, C o 1. 3, lines 30- 65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

**Claim 15:**

36. Regarding disabling limitations of claim 15, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement

for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 16:**

37. Regarding disabling limitations of claim 16, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 17:**

38. Regarding the enabling limitations claim 17, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

**Claim 18:**

39. Regarding the enabling limitations claim 18, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

**Claim 33:**

40. Regarding disabling limitations of claim 33, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 34:**

41. Regarding disabling limitations of claim 34, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied

items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

**Claim 35:**

42. Regarding disabling limitations of claim 35, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

***Examiner Note***

43. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Conclusion***

44. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

46. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any

claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

47. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

48. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

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